

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of **FARER, et al.**

Confirmation No.: **5265**

U.S. Patent number: **7,537,753**

Issue Date: **May 26, 2009**

Application No.: **10/520,561**

Filed: **January 7, 2005**

Attorney Docket No.: **3975-038**

For: **MOISTURE-PROOF MASCARA COMPOSITION**

VERIFIED STATEMENT PURSUANT TO 37 C.F.R. 5.25(a)(3)

Mail Stop L&R

Commissioner for Patents

P.O. Box 1450

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I, Mr. Wolf-Juergen Walter, do declare:

I.

I am an attorney at Gulde, Hengelhaupt, Ziebig & Schneider, a German law firm specializing in German and European intellectual property law. Among my other credentials, I am registered as both a German Patent Attorney and a European Patent Attorney.

II.

This verified statement relates to the filing of the following patent applications filed outside the United States:

German Appln. No.: **DE 10233288.6 filed July 18, 2002**

Int. Appln. No.: **PCT/EP03/07751 filed July 16, 2003**

Canadian Appln. No.: **CA 2,492,105 filed July 16, 2003**

EPO Appln. No.: **EP 03765010.8 regional phase filed July 16, 2003, that issued as EPO Patent No. 1523299 of May 24, 2006 and was validated in DE, ES, FR, GB, IT, MC & NL.**

For simplicity, I will refer to these foreign filings generically as the “Foreign Applications.” Similarly, the filing dates of the Foreign Applications as the “Foreign Filing Dates.”

III.

The subject matter of the above-identified Foreign Applications was not under a secrecy order at any time on or between the Foreign Filing Dates. Furthermore, the subject matter of the Foreign Applications filed outside the United States is not currently under a secrecy order.

IV.

This petition for issuance of a retroactive foreign filing license has been diligently pursued after discovery of the need for a foreign filing license. The above-identified Foreign Applications were filed on the Foreign Filing Dates. The assignee of the patent applications is Coty B.V., a Dutch corporation. My firm, Gulde, Hengelhaupt, Ziebig & Schneider (GHZS), which specializes in German and European intellectual property, serves as intellectual property counsel to Coty B.V., a Dutch entity and the assignee of the instant U.S. Patent Application, and Coty Deutschland GmbH, a German entity.

Because Coty Deutschland GmbH and Coty B.V. are European firms and because the German and European Patent Offices are issuing a first Search Report or Examination Report very quickly (within 6-9 months after filing), it has been our practice to first file patent applications in Germany or Europe and then, if international protection is desired, file a PCT application and/or applications directly in foreign countries, *e.g.*, the United States. Historically, (*i.e.*, prior to learning about the foreign filing license requirement in the United States) we have used the same filing strategy for all applications assigned to Coty B.V. and Coty Deutschland, GmbH, from Coty Inc., USA. Coty Deutschland GmbH and Coty B.V. are subsidiaries of Coty Inc. USA, and have employees which are resident in the USA. The

subject matter of the Foreign Applications at issue in this Petition was invented by employees of Coty Inc., USA, but assigned to Coty B.V., a Dutch entity.

The need for a foreign filing license was discovered during the preparation of another application (U.S. Application Serial No. 12/681,571) filed in the United States with Coty USA inventors. On March 31, 2010, we sent instructions to our U.S. associate, Novak Druce + Quigg, LLP, to file a U.S. national phase entry of international application PCT/EP2008/063204, which was filed October 2, 2008 and claimed priority to European application EP 07117999.8 filed October 5, 2007. The U.S. national phase entry was filed April 2, 2010, and assigned U.S. Application Serial No. 12/681,571. The '571 Application was filed without a declaration or power of attorney and a Notice of Missing Parts was issued by the Patent Office on June 18, 2010. The U.S. associate has advised that while preparing a response to the Notice of Missing Parts on October 1, 2010, the U.S. associate observed that all of the inventors of the '571 Application were U.S. residents with mailing addresses in the United States. Based on this information, U.S. counsel contacted my colleague Dr. Marlene Ziebig to determine whether or not the invention occurred in the United States and a foreign filing license was necessary.

From October 1, 2010 through October 11, 2010, our primary contact at the U.S. associate was not available due to travel to a conference in Europe. On Thursday, October 14, 2010, U.S. counsel attempted to contact my colleague Dr. Marlene Ziebig who is responsible for the '571 Application; however, they did not speak until October 15, 2010. Dr. Ziebig explained to me that during the conversation, U.S. counsel advised her about 35 U.S.C. §184 and the need for a foreign filing license for inventions made in the United States. The same day, U.S. counsel sent a letter describing the requirements of a petition for retroactive foreign filing license and advising that other applications by Coty Inc., USA inventors may also require a retroactive foreign filing license.

The instant application, U.S. Application Serial No. 10/520,561, was identified by our subsequent search of our records for applications filed with Coty Inc., USA inventors. On October 26, 2010, we forwarded U.S. counsel a list of applications that might require a

retroactive foreign filing license and asked them to proceed with preparing petitions for retroactive foreign filing licenses. As a result, this Verified Statement and the accompanying Petition for Retroactive Foreign Filing License were prepared.

Based on my current understanding of the circumstances surrounding conception of the subject matter of the instant application (the '561 application), I believe that a foreign filing license may be necessary. I was not aware of the U.S. foreign filing license requirement when I filed the Foreign Applications. In fact, I was not aware of the foreign filing license requirement until October 25, 2010, when I spoke with Dr. Ziebig about her conversation with U.S. counsel. Once we learned of the foreign filing license requirement, we immediately began identifying cases with Coty Inc., USA inventors where Petition for Retroactive Foreign Filing License might be necessary. This information was forwarded to U.S. counsel on October 26, 2010. Accordingly, this petition for issuance of a retroactive license for foreign filing has been diligently pursued.

V.

The above-identified Foreign Applications were filed through error and without deceptive intent before obtaining a foreign filing license. At the time the Foreign Applications were filed, I was not aware of the requirement of a foreign filing license for inventions made in the United States. It was not until October 25, 2010 that I learned of the potential foreign filing license issue. Immediately after recognizing the error, we began the process of seeking Petitions for Retroactive Foreign Filing Licenses for cases with Coty, Inc., USA inventors. Thus, the above-identified Foreign Applications were filed outside the United States without a foreign filing license through error and without deceptive intent.

VI.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so

made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, or any patent issued thereon.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wolf-Juergen Walter', written over a horizontal line.

Mr. Wolf-Juergen Walter